

# **Interview Summary**

**Application No.**

09/786,477

**Applicant(s)**SEMENCHENKO, MICHAEL  
GRIGORIEVICH**Examiner**

Brian P. Werner

**Art Unit**

2621

All participants (applicant, applicant's representative, PTO personnel):

(1) Brian P. Werner (Primary Examiner)(3) Dennis R. Riano (examiner)(2) Alexander Rabinovich

(4) \_\_\_\_\_

Date of Interview: 5/7/04Type: a) ☒ Telephonic b) ☐ Video Conferencec) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: \_\_\_\_\_


Claim(s) discussed: N/AIdentification of prior art discussed: N/AAgreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: \_\_\_\_\_ See Attachment

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.



Examiner's signature, if required

## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

#### Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

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\*\*\* TX REPORT \*\*\*  
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TRANSMISSION OK

TX/RX NO 0987  
CONNECTION TEL 912485940610  
SUBADDRESS  
CONNECTION ID  
ST. TIME 05/07 14:15  
USAGE T 00'52  
PGS. SENT 4  
RESULT OK



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## Fax Cover Sheet

Date: 07 May 2004

To: Alexander Rabinovich	From: Brian P. Werner
Application/Control Number: 09/786,477	Art Unit: 2621
Fax No.: 248-594-0610	Phone No.: 703-306-3037
Voice No.:	Return Fax No.: (703) 872-9306
Re:	CC:
<input type="checkbox"/> Urgent <input type="checkbox"/> For Review <input type="checkbox"/> For Comment <input type="checkbox"/> For Reply <input type="checkbox"/> Per Your Request	

Comments:

S/N 09/786,477 is a 371 application,  
NOT a CIP. An explanation is attached.



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<b>Voice No.:</b>	<b>Return Fax No.:</b> (703) 872-9306
<b>Re:</b>	<b>CC:</b>

☐ **Urgent**    ☐ **For Review**    ☐ **For Comment**    ☐ **For Reply**    ☐ **Per Your Request**

**Comments:**

S/N 09/786,477 is a 371 application,  
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Number of pages 4 including this page

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Alexandria, VA 22313-1450

## ATTACHMENT TO INTERVIEW SUMMARY

### Background

On January 16, 2004, an Office Action was mailed that addressed claims 1-26.

On April 19, 2004, an amendment was received from the applicant indicating, where claims 1-26 were indicated as being either "amended" or "previously presented".

On April 28, 2004, a notice of non-compliant amendment was mailed by the Office indicating that there were 23 original claims (NOT 26 claims), and that claims 24-26 in the amendment should be labeled as "new".

On May 5, 2004, applicant's representative Alexander D. Rabinovich (Reg. 37,425) telephoned legal instrument examiner Davina Williams regarding the notice of non-compliant amendment, inquiring why the notice of non-compliant amendment regarded claims 24-26 as "new" when the examiner had examined 26 original claims (including claims 24-26).

### Conclusion by the Primary Examiner

Claims 1-23 were the originally filed claims (not claims 1-26; which were filed as part of an improper CIP specification as discussed below), and the Office Action should have

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addressed only claims 1-23. The notice of non-compliance is correct. An explanation shall follow:

All of the papers filed with the instant application indicate that it was filed as a 371, National Stage Entry of a PCT application. **Thus, the current status of the instant application is that it is a "371" of PCT/RU99/00272 filed on August 4, 1999, which claims the benefit of Russian Federation patent application 98116546, filed on September 3, 1998. The US filing date of the 371 is March 2, 2001.**

However, it appears that on March 02, 2001 (the filing date of the 371), two separate specifications were filed. The first specification (referred to below as the original specification) appears to be the specification presented in the international examination, and contained claims 1-23. The second specification (referred to below as the CIP specification) is designated as a "continuation-in-part of PCT application WO 00/14684" in the first paragraph, and contains new matter as well as presenting claims 1-26 (claims 24-26 being added, and directed to the new matter). This CIP specification, even though it was filed alone with the proper, original specification on the same date, is improper as containing new matter.

The examiner mistakenly addressed second CIP specification, and thus examined 1-26.

**The second (CIP) specification is improper as presenting new matter in a 371 application.** Given that the claims 1-23 of both specifications are identical, the Office

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Action is not defective with respect to those claims. The applicant is advised to disregard the rejections of claims 24-26 and to disregard the CIP specification with respect to future correspondence. From here forward, the examiner shall refer to the first (original) specification and claims, and all amendments to either the specification or claims should be with respect to the original specification, including claims 1-23.

Thus, the notice of non-compliant amendment is proper. Should application wish introduce new claims (i.e., claims in addition to original claims 1-23), he may do so by labeling them as "new" claims in any future amendment. However, new matter should NOT be entered in a 371 application, and thus re-introducing claims 24-26 of the CIP specification would most likely be rejected under 35 USC 112, first paragraph.

Should applicant wish to pursue the CIP application (i.e., either by filing a CIP of the instant application or by converting the instant application into a proper CIP), the applicant is advised to contact the PCT Help Desk at 703-305-3257 for further assistance. The examiner does not have the authority to do this.

Any questions regarding this correspondence, please contact me at the number below.



Brian Werner  
Primary Examiner  
Art Unit 2621  
May 7, 2004

**BRIAN WERNER**  
**PRIMARY EXAMINER**